

## REMARKS

At the outset, Applicants thank the Examiner for the thorough review and consideration of the subject application. The Non-Final Office Action of November 20, 2003, has been received and its contents carefully noted. Claim 9 has been amended and claims 39-50 are newly added. Support for these amendments and newly added claims are provided in at least FIG. 8 and related text of the specification. No new matter is added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

### *Election Restriction*

The Examiner maintains the restriction requirement and submits that the restriction is without traverse. Applicants respectfully traverse the restriction requirement.

In response to the restriction requirement stated in the outstanding Office Action dated September 8, 2003, again Applicants elect, with traverse, the invention recited in claims 9-11 and alleged species that read on these claims, for further examination on the merits.

Applicants respectfully traverse the restriction requirement as being outside the boundaries established in MPEP § 806.04(e) and § 806.04(f). First, the restriction requirement appears to be based solely on a finding that the different inventions are patentably distinct, without any evaluation whatsoever made with respect to whether or not the inventions are "specifically different embodiments" as required in MPEP § 806.04(e). Furthermore, the outstanding restriction requirement fails to provide any basis for finding that the restricted claims are mutually exclusive as required by MPEP § 806.04(f).

More specifically, the Examiner asserts that groups I, II, and III are distinct from each other. The Examiner alleges these group have different modes of operation. Applicants

respectfully submit these groups have similar modes of operation as an liquid crystal display (LCD).

Indeed, merely finding that claims are patentably distinct does not provide a basis for requiring an election of inventions, since if that were the case every dependent claim ever submitted in an application would be properly the subject of a restriction requirement, which of course is not the case.

In light of the deficiencies above-identified in the outstanding restriction towards at least groups I, II, and III. Additionally, the Examiner asserts the Applications contains patentably distinct species. Applicants specifically traverse these species restrictions. In restriction requirement, the Examiner has merely asserted the species are distinct as being related to different embodiments. The Examiner is respectfully directed towards MPEP § 806.04(f) requiring different species to be mutually exclusive. That is, to properly restrict claims to species they must be mutually exclusive. The Examiner has not satisfied this burden.

Accordingly, it is respectfully submitted that certainly the restriction of claims 8-11 and 26-29 is not properly established as being directed to different mutually exclusive inventions, and at the very least it is respectfully submitted that these claims should be examined in the present application consistent with the present and previous election. Further, in view of the similarity of elected claims 9-11 it is respectfully submitted that it would not be unduly burdensome for the remaining claims also to be examined in the present application.

Accordingly, in view of the present and previous election, and in view of the arguments in traversal of the outstanding restriction requirement, examination on the merits of each of the pending claims is believed to be in order, and an early and favorable action is respectfully requested.

***Title Objection***

In the Office Action, the title of the invention was objected to as not being descriptive.

The title has been amended to read:

-- Liquid Crystal Display and Spacers --

Accordingly, Applicants respectfully request withdrawal of the objection to the title.

***Specification Objection***

In the Office Action, the specification was objected to as allegedly failing to provide proper antecedent basis. Applicants respectfully traverse this objection.

Apparently, the Examiner is alleging there is no written description for the claimed subject matter. Applicants respectfully direct the Examiner to the § 2163.04 of the MPEP disclosing:

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). ***The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.*** *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

*See MPEP § 2143 (8th Ed., Rev. February 2003)(emphasis added).*

The Examiner has not established with a preponderance of evidence why a person skilled in the art would not recognize the invention defined by the claims. Rather, the Examiner merely asserts, “[t]he specification (page 21), the first and second protrusion are formed with ONLY one of a photosensitive organic insulating material, a positive or negative photosensitive material, or a silicon-based insulating material.” (Office Action at 4.) In contradiction to the Examiner assertions, this statement provides express support for the claimed invention. More specifically, one of ordinary skill would recognize a positive and negative photosensitive material includes a photoresist material. Additionally, the originally filed claim 10 provides direct support for photoresist film.

Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

***Abstract Objection***

In the Office Action, the Abstract was objected to as it allegedly does not clearly state which is new in the art to which the invention pertains. Applicants respectfully traverse this objection and reconsideration is hereby requested.

The Examiner has not provided evidence supporting the assertion that the abstract does not clearly state which is new in the art to which the invention pertains. Applicants respectfully submit the abstract is concise statement of the technical disclosure of the patent. Applicants respectfully submit the abstract is in full compliance of 37 CFR § 1.72.

Accordingly, Applicants respectfully request withdrawal of the objection to the Abstract.

***Rejections Under 35 U.S.C. §102***

Claims 9-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,501,529 issued to Kurihara, *et al.* ("Kurihara"). Applicants respectfully traverses this rejection for at least the following reasons.

Claim 9 is allowable over the cited references in that claim9 recites a combination of elements, including, for example:

a common electrode formed on the color filter color filter; and first and second protrusions formed on the common electrode, the first protrusion having a first thickness, the second protrusion having a second thickness, the second thickness being greater than the first thickness.

Kurhara does not teach at least these features.

The Examiner asserts the "first 32 and second protrusions 32 formed on the common electrode, the first protrusion having a first thickness, the second protrusion having a second thickness, the second thickness being greater than the first thickness." (Office Action at 5.) In contradistinction, the alleged second protrusion 32 is not formed on the common electrode 25. Rather, referring to column 4, lines 63-65 of Kurhara disclosing: "the convex-shaped part 31 is disposed on the pixel electrode drive wiring 26 as shown in FIG. 8." This alleged second protrusion 32 is not formed on the common electrode.

Moreover, Kurhara is directed towards a touch sensor using a resistive membrane method. More specifically, Kurahara discloses at column 4, lines 26-48 the following:

Additionally, in the present invention, a touch electrode may be disposed on a convex-shaped part. In FIG. 8, a convex-shaped part 31 is formed on the pixel electrode drive wiring 26, and the first touch electrode 27 is formed thereon. The pixel electrode drive wiring 26 and the convex-shaped part 31 may be formed so as not to overlap or to partially overlap with each other. Additionally, the convex-shaped part 31 may be formed on the surface of the second

substrate 17 or on both surfaces of the first substrate 14 and the second substrate 17. In either case, a distance between the first touch electrode 27 and the second touch electrode 24 can be narrowed as compared with the case where the convex-shaped part is not in use. As shown in FIG. 8, as a height of the convex-shaped part 31 is smaller than that of the pillar-shaped spacer 32, a gap having a much thinner thickness than that of the liquid crystal layer is formed between the first touch electrode 27 and the second touch electrode 24. Accordingly, since forming the convex-shaped part 31 enables detection of a touch point by light depression of a substrate surface, a liquid crystal display element incorporating a touch sensor unit exhibiting excellent position detectability by a touch operation can be obtained.

More specifically, element 23, touch electrode 24, first touch electrode 27, and convex-shaped part 31 are not protrusions, rather, they are part of the touch sensor as shown from the forgoing description.

Accordingly, Applicants respectfully submit claim 9 and claim 10, which depends from claim 9, are allowable.

### ***Rejections Under 35 U.S.C. § 103***

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurhara in view of U.S. Patent No.6,567,144 issued to Kim, *et al.* ("Kim"). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 11 is allowable over the cited references for at least the similar reasons as discussed above with respect to claim 9. Kim fails to cure the deficiencies of Kurihara. Claim 11, by virtue of its dependency from claim 9, includes all the features of claim 9 and should be allowable over the applied art of record for the above reasons.

Accordingly, Applicants respectfully submit the rejection under 35 U.S.C. § 103 should be withdrawn.

***Added Claims***

In this response, claims 39-50 are newly added in order to capture the subject matter of the invention from different perspectives. These claims 39-50 are directed to the features fully described in the specification but not disclosed or suggested in the art of record.


**CONCLUSION**

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



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